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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,176	10/24/2003	John Martin Burns	HSJ920030216US1	2612

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EXAMINER

RONESI, VICKY M

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,176

Applicant(s)

BURNS, JOHN MARTIN

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-18,20 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-18,20 and 23-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. All outstanding objections and rejections, except for those given below, are withdrawn in light of applicant's amendment filed 6/26/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed 6/26/2006. In particular, the claims have been amended to recite an amount of 0.001-1 parts by weight perfluorinated polyether and 99-99.999 parts by weight of the solvent and solubilizer. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 112

4. Claims 1, 3-10, 12-18, 20, and 23-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1, 3-5, 9, 10, 12-14, 18, 24, 26, 28, 31, and 33, the rejection is adequately set forth in paragraph 2 of Office action mailed 3/21/2006 and is incorporated here by reference.

With respect to the other claims, they are rejected for being dependent on a rejected claim.

In response to applicant's argument that language "solubilizer is selected from alcohols and cyclic ethers" is proper Markush language, the MPEP is very clear regarding Markush language and it necessarily includes the language "selected from the group consisting of."

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MPEP § 2173.05(h). Also note that applicant's citation of "TRAINING MATERIALS FOR EXAMINING PATENT APPLICATIONS" is for 35 USC 112, first paragraph and is not pertinent in this discussion of 35 USC 112, second paragraph.

Claim Rejections - 35 USC § 103

5. Claims 1, 3, 4, 6-10, 12, 13, 15-18, 20, 23-26, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuki et al (US 5,292,585) in view of Nishimura et al (US 4,597,882).

Ohnuki et al discloses a purified perfluoropolyether lubricant that is used in a magnetic recording medium which is made by applying a magnetic recording layer to a substrate, applying a carbon layer (i.e., overcoat layer), and then applying the perfluoropolyether lubricant in a compatible solvent (col. 13, lines 10-20, 47-55). The lubricant is present in an exemplified concentration of 0.25 vol % (col. 11, lines 64-68).

Ohnuki et al teaches the use of fluorinated solvents (col. 5, lines 59-68), it does not teach the use of an alcohol added to the solvent.

Nishimura et al discloses fluorine-containing solvents compatible with fluorine-containing lubricant such as perfluoropolyether such as an azeotropic mixture of trichlorotrifluoroethane and ethanol and a mixture of trichlorotrifluoroethane and isopropanol (col. 3, lines 38-49).

Given that Ohnuki et al is open to the use of any fluorine-containing solvent compatible with perfluoropolyether, it would have been obvious to one of ordinary skill in the art to utilize a

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fluorine-containing solvent with an alcohol as the compatible solvent when preparing the magnetic recording medium of Ohnuki et al.

With respect to claims 7, 8, 16, and 17, Ohnuki et al teaches adding the perfluorinated polyether to a compatible solvent and Nishimura et al teaches adding the lubricant to a solvent mixture containing fluorine-containing solvent and alcohol, however, neither teaches mixing the lubricant first with the fluorine-containing solvent and then adding the alcohol or mixing simultaneously the lubricant, solvent, and alcohol. Nevertheless, it is considered that any mixing order is obvious since no criticality for the mixing order has been established. Case law holds that the selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930).

Response to Arguments

6. Applicant's arguments filed 6/26/2006 have been fully considered but they are not persuasive. Specifically, applicant argues that Ohnuki et al does not teach the use of an alcohol or even a solubilizer;

In response, the examiner agrees that Ohnuki et al does not teach the use of an alcohol or a solubilizer, however, that is exactly why the disclosure of Nishimura et al has been relied upon. While Nishimura et al does not disclose an amount of 0.001-1 parts by weight of perfluorinated polyether to about 99-99.999 parts by weight of solvent and solubilizer, these relative amounts are already provided for by Ohnuki et al which teaches that the lubricant (i.e., perfluorinated polyether) is present in an exemplified concentration of 0.25 vol % (col. 11, lines 64-68).

Allowable Subject Matter

7. Claims 5, 14, and 27-32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: neither Ohnuki et al nor Nishimura et al teaches the use of cyclic ethers or halogenated alcohols as a solubilizer of fluorinated solvent and perfluorinated polyethers.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burdzy et al (US 6,486,103) discloses a perfluoropolyether lubricating composition containing cyclic ethers as the organic solvent, however, it fails to teach cyclic ethers in combination with fluorinated solvents in relative amounts presently claimed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/11/2006
Vickey Ronesi



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